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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,251	06/20/2003	Samuel A. Fedele	D/A2469	6692

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EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
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2141

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/601,251	Applicant(s) FEDELE, SAMUEL A.	
	Examiner Kenneth R. Coulter	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/03</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Objections

1. Claims 29 and 31 are objected to because of the following informalities:

Claim 29 appears twice.

No claim 31 exists.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45 - 47 recite the limitation "The computer program" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 25 and 45 – 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Claims 1 – 25 and 45 – 47 are directed to software (computer program) that is not implemented on a computer-readable **storage** medium.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Malik (U.S. Pat. Pub. No. 2002/0065892) (Method and Apparatus for Minimizing Storage of Common Attachment Files in an E-Mail Communications Server).

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4.1 Regarding claim 1, Malik discloses a computer program arranged to process a first message, the first message comprising a first data object, the process based on a method comprising:

(a) forming a second data object based on the first data object, the second data object to be stored in a storage device at a storage address (Abstract; paragraphs 20, 26, 35);

(b) forming a reference information (pointer) based upon the storage address (Abstract; Fig. 3; paragraphs 20, 30); and

(c) forming a second message comprising the reference information and devoid of at least part of the first data object (Abstract; Fig. 3; paragraphs 20, 30).

4.2 Per claim 2, Malik teaches the computer program of claim 1, wherein at least a portion of the computer program resides on a message client (paragraphs 13, 21, 24).

4.3 Regarding claim 3, Malik discloses the computer program of claim 2, wherein the computer program further comprises a plug-in program in operable communication with a message client program (Abstract; Fig. 2; paragraphs 13, 21, 24).

4.4 Per claim 4, Malik teaches the computer program of claim 2, where the computer program is an e-mail client computer program (Abstract; Fig. 2; paragraphs 13, 21, 24).

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4.5 Regarding claim 5, Malik discloses the computer program of claim 1, wherein at least a portion of the computer program resides on a message server (Fig. 2; paragraphs 13, 21, 24).

4.6 Per claim 6, Malik teaches the computer program of claim 5, wherein the message server is an e-mail server (Abstract; Figs. 1, 2; paragraphs 10, 11).

4.7 Regarding claim 7, Malik discloses the computer program of claim 1, the method further comprising sending the second message to a recipient (Abstract; Figs. 1 – 3).

4.8 Per claim 8, Malik teaches the computer program of claim 7, wherein sending the second message occurs via a communications network (Abstract; Figs. 1 – 3).

4.9 Regarding claim 9, Malik does not explicitly disclose the computer program of claim 8, wherein the communications network comprises a wireless network. However, the delivery of a message across a wireless network requires close consideration of bandwidth limitations. Malik mitigates bandwidth problems associated with large email attachments.

It would have been inherent to implement the invention of Malik in a wireless network, because Malik reduces the size of email with large attachments.

4.10 Per claim 10, Malik teaches the computer program of claim 8, wherein the

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communications network comprises an internet (paragraphs 4, 6).

4.11 Regarding claim 11, Malik does not explicitly disclose the computer program of claim 1, the method further comprising setting access controls restricting access to the second data object.

However, it is inherent to limit access to the saved attachment to prevent unauthorized access to the attachment, as seen in Jhingan et al. (U.S. Pat. No. 7,113,948) (col. 5, line 65 – col. 6, line 11).

4.12 Per claim 12, Malik teaches the computer program of claim 11, the first message comprising an e-mail message (Abstract; Figs. 1, 2, 3).

4.13 Regarding claim 13, Malik discloses the computer program of claim 12, the second message comprising an e-mail message (Abstract; Figs. 1, 2, 3).

4.14 Per claim 14, Malik teaches the computer program of claim 1, the method further comprising determining when the size of the first data object exceeds a threshold (Abstract; paragraphs 20, 26, 35).

4.15 Regarding claim 15, Malik discloses the computer program of claim 14, wherein the threshold is one thousand bytes (paragraph 25).

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4.16 Per claim 16, Malik teaches the computer program of claim 14, wherein forming a second data object, forming a reference information, and forming a second message are performed only when the size of the first data object exceeds the threshold (Abstract; paragraphs 20, 26, 35).

4.17 Regarding claim 17, Malik discloses the computer program of claim 14, wherein the threshold is determined by a threshold policy component (Abstract; paragraphs 20, 26, 35).

4.18 Per claim 18, Malik teaches the computer program of claim 17, wherein the threshold policy component is a local threshold policy component (Abstract; paragraphs 20, 26, 35).

4.19 Regarding claim 19, Malik discloses the computer program of claim 17, wherein the threshold policy component is a network policy component (Abstract; paragraphs 20, 26, 35).

4.20 Per claim 20, Malik teaches the computer program of claim 14, wherein the threshold is a fixed value that is part of the program code (Abstract; paragraphs 20, 26, 35).

4.21 Regarding claim 21, Malik discloses the computer program of claim 1, where the

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storage device is a file server (Abstract; Figs. 1, 2; paragraphs 10, 11).

4.22 Per claim 22, Malik teaches the computer program of claim 21, wherein, the reference is a universal resource locator (URL) (Abstract; paragraphs 4, 6, 20, 30).

4.23 Regarding claim 23, Malik does not explicitly disclose the computer program of claim 21, wherein, the storage device is a Docushare server.

It would have been inherent to implement this specific device since this specific storage device is a commonplace industry option.

4.24 Per claim 24, Malik does not explicitly teach the computer program of claim 21, wherein the storage device is a Sharepoint server.

It would have been inherent to implement this specific device since this specific storage device is a commonplace industry option.

4.25 Regarding claim 25, Malik does not explicitly disclose the computer program of claim 21, wherein the storage device is a Lotus Notes server.

It would have been inherent to implement this specific device since this specific storage device is a commonplace industry option.

4.26 Per claims 26 – 71, the rejection of claims 1 – 25 under 35 USC 102(b) (paragraphs 4.1 – 4.25 above) applies fully.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M – F, 7 – 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KENNETH R. COULTER
PRIMARY EXAMINER



krc